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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,429

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Jean-Luc Carrez

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EXAMINER

TANNER, JOCELIN C

ART UNIT

PAPER NUMBER

3731

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,429	<b>Applicant(s)</b> CARREZ ET AL.	
	<b>Examiner</b> JOCELIN C. TANNER	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office Action is in response to the Amendment filed 24 June 2010. Claims 1-9 are currently pending. The Examiner acknowledges the amendments to claims 1-5.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "device" in line 22. There is insufficient antecedent basis for this limitation in the claim. For the purposes of art rejections, the limitation "device" will be treated as the "retention device".

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 5, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell (US Patent No. 5,865,806) in view of Botich et al. (US Patent No. 6,077,244).**
6. Regarding claims **1 and 6**, Howell discloses an arrangement for the insertion into a vein of a cannula including a proximal base (11) of a short tubular catheter (column 2,

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lines 65-67), a needle (20) having a skin-puncture end (column 3, lines 61-65, Fig. 1), an anti-prick cage (50) which extends the base in the proximal direction, the anti-prick cage forming a chamber through which the needle slides from a proximal entrance to a distal exit of the chamber, the cage and base having retention resources that combine to perform temporary retention of the cage on the catheter base before the puncture end of the needle is trapped in the chamber of the cage, the retention resources including an external rim (Fig. 4) formed on the proximal end of the base and an external dog that is held in place by the rim, the dog is formed at one end of a retention device. The retention device is capable of sliding on its own, unbiased by any force other than its own weight, from a position permitting withdrawal of the needle through the opening (61) and into the cage to a position blocking the exit of the needle from the cage, the retention device being capable of sliding out when it is not longer in contact with the needle such that the dog lifts and releases itself from the rim to position the distal end of the retention device in front of the puncture end to prevent the end from exiting the chamber, the only friction between the needle and the opposite end of the retention device being due to the weight of the end of the device (column 5, lines 10-25, Fig. 5). However, Howell fails to disclose a retention device being capable of tilting in the cage around a pivoting axis transverse to the sliding direction of the needle.

Botich et al. teaches a catheter insertion device with a retractable needle including a needle retainer (40) that is pivotably attached to the housing or "cage" (30) by a pivot (42) wherein the needle retainer is capable of tilting about the axis that is

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transverse to the sliding direction of the needle such that re-engagement of the base will not be prevented(column 4, lines 20-40, Figs. 3, 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached the retention device of Howell to the cage via a pivot such that one end of the retention device is capable of engaging the catheter and the other end of engaging the needle at an angle, as taught by Botich et al., such that the retention device slides down unbiased and then pivots, thus causing the needle contacting end of the retention device to pivot toward the distal end of the cage such that inference of the base and the rim contacting retention end is prevented during re-engagement.

7. Regarding claim **2**, the combination of Howell and Botich et al. discloses the weight of the part of the retention device located between the pivoting axis and the retention device that engages the rim is less than the weight of the part of the retention device located between the axis and the end that contacts the needle.

8. Regarding claims **5 and 9**, the combination of Howell and Botich et al. discloses a retention device having an integral flexible protrusion or “tongue” (62) (everything has a degree of flexibility) which is movable from a disengaged position distal from an upper wall of the cage (Fig. 4) to a position wherein the tongue is trapped under the wall of the cage (Fig. 5) wherein the retention device is capable of tilting (Botich et al.) as a result of withdrawing the needle.

9. **Claims 3, 4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell (US Patent No. 5,865,806) in view of Botich et al. (US**

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**Patent No. 6,077,244), as applied to claims 1 and 2 above, and further in view of Gaba (US Patent No. 5,697,907).**

10. Regarding claims **3 and 7**, the combination of Howell and Botich et al. discloses all of the limitations previously discussed except for the pivoting axis including lateral nipples formed on the retention device and accommodated in a cradle formed on the cage.

Gaba teaches a device to prevent exposure of a needle point including a pivoting retainer (318) wherein lateral nipples (310) formed thereon and accommodated within a cradle created by cut-outs in two opposite walls of housing (column 5, lines 3-5, Figs. 10-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a cradle within the housing of the needle and lateral nipples on the retention device of the combination of Howell and Botich et al., as taught by Gaba, since it is well known to obtain pivoting function by providing a cradle in which pins/nipples rest and oscillate to bestow pivoting movement.

11. Regarding claims **4 and 8**, Gaba teaches a cradle that is capable of being placed within the housing by click-on action.

### ***Response to Arguments***

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOCELIN C. TANNER whose telephone number is (571)270-5202. The examiner can normally be reached on Monday through Thursday between 9am and 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jocelin C. Tanner/  
9/03/2010  
Examiner, Art Unit 3731

/Anh Tuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
9/9/10